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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
(SAN FRANCISCO DIVISION)

FINJAN LLC,

Plaintiff,

v.

PALO ALTO NETWORKS, INC.,

Defendant.

Case No. 14-cv-04908-JD

**JOINT STIPULATION RE  
DISMISSAL OF THREE  
PATENTS-IN-SUIT**

Hon. James Donato  
Courtroom 11, 19<sup>th</sup> floor

1 Plaintiff Finjan LLC (“Finjan”) and Defendant Palo Alto Networks, Inc. (“PAN”) hereby  
2 agree and stipulate:

3 In Finjan’s case against ESET, LLC, pending in the United States District Court for the  
4 Southern District of California, Judge Bencivengo found that the asserted claims of U.S. Patent No.  
5 6,804,780 (“the ’780 Patent”) and four other Finjan patents are invalid on the grounds that the claim  
6 term “Downloadable,” as used in those claims and construed by that court, is indefinite. *Finjan,*  
7 *Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB-BGS, Dkt. No. 869 (S.D. Cal. Mar. 29, 2021). Based  
8 on that order, Judge Bencivengo entered judgment of invalidity with regard to those patents. *Id.* at  
9 Dkt. No. 875 (May 20, 2021). Finjan has filed a notice of appeal of that judgment to the Federal  
10 Circuit. *Id.* at Dkt. No. 878 (June 17, 2021).

11 Finjan has asserted the ’780 Patent in this case against PAN. Finjan also has asserted two  
12 other patents that—although not asserted in *ESET* and therefore not included in Judge Bencivengo’s  
13 order and judgment—also use the claim term “Downloadable,” namely U.S. Patent No. 7,613,926  
14 (“the ’926 Patent”) and U.S. Patent No. 8,677,494 (“the ’494 Patent”).

15 In light of Judge Bencivengo’s order and judgment, the parties have agreed to dismissal of  
16 Finjan’s claims of infringement of the ’780 Patent (Counts I and II of Dkt. No. 112), the ’926 Patent  
17 (Counts V and VI), and the ’494 Patent (Counts XIII and XIV) on the following terms:

18 1. In the event the judgment of invalidity of the ’780 Patent becomes final without any  
19 further appeal, the dismissal shall then be with prejudice; and

20 2. The dismissal shall be without prejudice to Finjan’s reassertion of these three patents  
21 against PAN by filing a new infringement action if and only if the judgment of invalidity of the ’780  
22 Patent is reversed or vacated on appeal.

23 Likewise, the parties have agreed to dismissal without prejudice of PAN’s counterclaims for  
24 the ’780, ’926, and ’494 Patents (Counts I, II, V, VI, XIII, XIV, XV, and XVII of Dkt. No. 116) and  
25 defenses for the ’780, ’926, and ’494 Patents.

26 Finjan and PAN have entered into a separate and contemporaneous Patent Assertion  
27 Agreement that includes a tolling provision relating to damages for the ’780, ’926, and ’494 Patents  
28 should the judgment of invalidity of the ’780 Patent be reversed or vacated on appeal and should

1 Finjan file a new infringement action.

2 Each party shall bear its own costs and fees pertaining to the dismissed patents.

3 **IT IS SO STIPULATED, THROUGH COUNSEL OF RECORD.**

4  
5  
6 Dated: August 23, 2021

Respectfully Submitted,

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**ATTESTATION PURSUANT TO CIVIL L.R. 5-1(i)**

In accordance with Civil Local Rule 5-1(i)(3), I attest that concurrence in the filing of this document has been obtained from any other signatory to this document.

/s/ Roger A. Denning  
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